

### REMARKS

Claims 1, 3-13, 15-25, 28-37, and 39-48 are pending in the present application. Claims 1, 13, 25, and 37 have been amended. The amendments do not add new matter and find support throughout the specification and claims. In view of the amendments and following remarks, reconsideration and allowance of the present application is respectfully requested.

Claims 1, 3-13, 15-25, 28-37, and 39-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 5,956,021 to Kubota et al. (hereinafter Kubota), in view of United States Patent No. 5,543,818 to Scott (hereinafter Scott). Applicants respectfully traverse.

Claim 1 relates to an information entry method that is computer-executable. The method of amended claim 1 includes, among other things, displaying each of a plurality of groups, which respectively contains *a plurality of information grouped according to a predetermined rule, so that each information contained in each group is displayed*. In the method of amended claim 1, each group is displayed so that a predetermined information contained therein is *displayed in an enlarged manner as compared with the other information in the group selection mode, and the predetermined information is defined beforehand*.

The Examiner asserts that Kubota discloses the feature of "displaying each of a plurality of groups, which respectively contains a plurality of information grouped according to a predetermined rule, so that each information contained in each group is displayed" at col. 4, lines 14-22. (Office Action; page 3, lines 7-10). The Examiner recognizes that Kubota does not disclose displaying each item of information contained in each group, but asserts that Scott discloses this feature in the Abstract, figure 1, and at col. 2, lines 1-10. Scott apparently discloses displaying a character as a small letter or a large letter according to *operation of a Shift key* in

the case of selection of the character (Scott; col. 2, lines 1-10). The character of the object, which is displayed in an enlarged manner in an information selection mode is apparently *variable* by input operation of a user in Scott. However, Scott does not disclose or suggest that the predetermined information is displayed in an enlarged manner as compared with the other information *in the group selection mode*, but rather apparently discloses the enlarged character to indicate an opportunity to select the individual character. Additionally, Scott does not disclose or suggest that the predetermined information is defined beforehand, as for example, a representative character in a group, and not changed according to input operation of a user. Therefore, neither reference discloses or suggests all of the features of amended claim 1, and therefore for at least this reason the claim is allowable.

Additionally, the Examiner asserts that the motivation to combine the references is provided by the user benefit of easier text and information entry using fewer keystrokes and/or button actuations (Office Action; page 5, lines 11-13; citing Kubota; col. 2, lines 23-28; and Scott; col. 1, lines 10-22). However, the purported motivation does not provide a reason for one skilled in the art and aware of Kubota to be motivated to look to Scott, or vice versa. The conclusory reasoning of the Office Action is insufficient to support a claim of obviousness. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either *explicitly or implicitly in the references themselves or in the knowledge generally available* to one of ordinary skill in the art. (MPEP 2143.01, emphasis added). "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

The Federal Circuit addressed the standard for obviousness and the requirement of motivation in Teleflex, Inc. et al. v. KSR Int'l Co., (119 Fed. Appx. 282; 2005 U.S. App. LEXIS 176). The patent at issue in *Teleflex*, related to an electronic pedal position control and a pedal assembly. In *Teleflex*, the district court granted a motion for summary judgment based on invalidity due to obviousness. The Federal Circuit vacated the decision and remanded to the lower court for further proceedings on the issue of obviousness. The Federal Circuit stated that, in regard to obviousness, "a person of ordinary skill in the art must not only have had some motivation to combine the prior art teachings, ***but some motivation to combine the prior art teachings in the particular manner claimed.***" (*Teleflex*, citing *In re Kozab*; emphasis added). The Federal Circuit found that there was no motivation to combine the Asano patent, which disclosed all of the limitations except the electronic control, and the Rixon patent, which disclosed an electronic control and an adjustable pedal assembly. As the court further stated:

[t]he district court correctly noted that the nature of the problem to be solved may, under appropriate circumstances, provide a suggestion or motivation to combine prior art references. However, ***the test requires that the nature of the problem to be solved be such that it would have led a person of ordinary skill in the art to combine the prior art teachings in the particular manner claimed.***

(*Teleflex*, citing as background *Rouffet*, 149 F.3d at 1357; emphasis added).

It is respectfully submitted that the present rejection is similar to the rejection discussed in *Teleflex* in that there is no motivation provided in Kuboraa to combine its teaching with Scott. As the *Teleflex* court held, there must be specific teaching to motivate a person of ordinary skill in the art must to combine the prior art teachings in the particular manner claimed. Therefore, since there is no motivation to combine the references, the rejection is improper.

Claims 3-12 depend from claim 1 and are therefore allowable for at least the same reasons as claim 1 is allowable.

Independent claims 13, 25, and 37 have been amended in the same manner as claim 1 and include similar features. Therefore, these claims are allowable for at least the same reasons as claim 1 is allowable.

Claims 15-24 depend from claim 13, claims 28-36 depend from claim 25; and claims 39-48 depend from claim 37. Therefore these claims are allowable for at least the same reasons as their respective base claims are allowable.

Additionally, Applicants respectfully submit that the features of claims 3, 15, 28, and 39, namely, that a group selected in the group selection mode is displayed in an enlarged manner as compared with the other groups, is not disclosed or suggested in any of the references. The Examiner rejects claim 3 based on Kubota, citing col. 3, lines 13-18. However, it does not appear that Kubota discloses or suggests *enlarging a selected group as compared with other groups*. Kubota apparently discusses showing predetermined keys larger than other keys, and expanding provisionally selected keys. However, there is no indication in Kubota of enlarging or expanding a group containing a plurality of information. Likewise, Scon does not disclose enlarging a selected group, but rather apparently discloses enlarging a selected character. Therefore, claim 3 is allowable for at least this additional reason. Claims 15, 28, and 39 include features similar to those discussed above in regard to claim 3, and therefore these claims are allowable for at least the same reasons as claim 3 is allowable.

However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

